

REMARKS/ARGUMENTS

In the Office Action mailed September 22, 2008 (hereinafter, "Office Action"), claims 1-3, 9-11 and 17-19 stand rejected under 35 U.S.C. § 102. Claims 4-8, 12-16 and 18-24 stand rejected under 35 U.S.C. § 103. Claims 1-6, 8-14, 16-22 and 24 have been amended.

Applicant respectfully responds to the Office Action.

I. Claims 1-3, 9-11 and 17-19 Rejected Under 35 U.S.C. § 102(e)

Claims 1-3, 9-11 and 17-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,889,252 to Lacome D'Estalensx (hereinafter, "Lacome"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1 as amended recites "wherein the method is performed by the client device, the method comprising: determining the network address of the peripheral device, wherein determining includes: retrieving a first data file from the server device, wherein the first data file is a web page; identifying one or more portions of the retrieved first data file as potential network addresses." Support for this amendment can be found in Applicant's specification on at least page 9, lines 11-17 and page 10, lines 3-13. Lacome does not disclose this subject matter.

Instead Lacome states:

In step **232**, once the terminal T has been connected to the server S through a network and a network session has been initiated between T and S, the user sends to the server S: information identifying the selected peripheral

P1, indicating that P1 is the peripheral to which output requests issued from the terminal T must be directed, as well as an information identifying the terminal itself. This information can have been already stored by the server at the initiation of the network session between the terminal and the server.

To perform steps **231** and **232**, the user can browse a resource list from a display imported on his terminal screen from the server S to select the desired peripheral.

Such a list can be logically organized and visually presented to the user, in different ways.

(Lacome, col. 6, lines 32-46).

Lacome thus describes obtaining “information identifying the selected peripheral.” This is accomplished by “the user brows[ing] a resource list from a display imported on his terminal screen.” The above cited portion of Lacome does not disclose “identifying one or more portions of the retrieved first data file as potential network addresses.” Instead, the above cited portion of Lacome describes a “logically organized” list “visually presented to the user” that allows a user to “select the desired peripheral.” The “logically organized” list of Lacome makes the step of “identifying one or more portions of the retrieved first data file as potential network addresses” unnecessary because the list of Lacome has already associated each peripheral with a network address.

Lacome further states:

A plug-in which has been installed on the terminal builds a message to be sent to the server through the network 1, said message:

containing an information identifying the terminal T, and requesting a network address for sending to such an address the actual and full output request (including the data to be edited). But the actual output request is not sent to the server S, the plug-in sends this message to the server through the network 1, when receiving this message from the terminal T, the server S scans the second table in its memory means, to determine which peripheral is associated to the terminal T. It is recalled that a preferred information for identifying the selected peripheral in the second table is the network address of the peripheral, and that if another type of identifying information is used to identify the selected peripheral, the server S nevertheless knows the network address of all peripherals, and is thus able to send back to the terminal T the

network address of the peripheral associated to the terminal, the plug-in then receives from the server – always through the network 1 – the network address of the selected peripheral.

(Lacome, col. 8, lines 32-52).

Lacome describes a server S “send[ing] back to the terminal T the network address of the peripheral associated to the terminal.” The above cited portion of Lacome does not disclose “identifying one or more portions of the retrieved first data file as potential network addresses.” Furthermore, because the peripheral has already been associated with the terminal, “identifying one or more portions of the retrieved first data file as potential network addresses” by the client device would be unnecessary in Lacome.

Claim 1 as amended further recites “comparing the one or more potential network addresses of the retrieved first data file with a predetermined data formatting pattern indicative of a network address; identifying one or more potential network addresses of the retrieved first data file as network addresses; and determining if a network address is the network address of the peripheral device.” Support for this amendment can be found in Applicant’s specification on at least page 10, line 14 – page 11, line 19. Lacome does not disclose this subject matter.

Lacome states:

In step **232**, once the terminal T has been connected to the server S through a network and a network session has been initiated between T and S, the user sends to the server S: information identifying the selected peripheral P1, indicating that P1 is the peripheral to which output requests issued from the terminal T must be directed, as well as an information identifying the terminal itself. This information can have been already stored by the server at the initiation of the network session between the terminal and the server.

To perform steps **231** and **232**, the user can browse a resource list from a display imported on his terminal screen from the server S to select the desired peripheral.

Such a list can be logically organized and visually presented to the user, in different ways.

(Lacome, col. 6, lines 32-46).

Lacome thus describes obtaining “information identifying the selected peripheral.” This is accomplished by “the user brows[ing] a resource list from a display imported on his terminal screen.” The above cited portion of Lacome does not disclose “comparing the one or more potential network addresses of the retrieved first data file with a predetermined data formatting pattern indicative of a network address; identifying one or more potential network addresses of the retrieved first data file as network addresses; and determining if a network address is the network address of the peripheral device.” Instead, the above cited portion of Lacome describes a “logically organized” list “visually presented to the user” that allows a user to “select the desired peripheral.”

In response to Applicant’s arguments made in the Response to the Office Action mailed March 17, 2008, the Office Action states that “the applicant argues that Lacome does not disclose, ‘comparing portions of at least one of said first and second data files with a predetermined data formatting pattern indicative of a network address’.” (Office Action, page 2). The Office Action disagreed stating “the data file mentioned in the cited embodiment of Lacome reads on the first data file because an address is clearly present in the data file.” (Id.) Lacome states that “the server S nevertheless knows the network address of all peripherals, and is thus able to send back to the terminal T the network address of the peripheral associated to the terminal.” (Lacome, col. 8, lines 49-52). Applicant does not disagree with the Office Action’s assertion that “an address is clearly present in the data file” of Lacome. However, sending a data file which includes a network address does not disclose “identifying one or more portions of the retrieved first data file as potential network addresses; comparing the one or more potential network addresses of the retrieved first data file with a predetermined data formatting pattern indicative of a network address; identifying one or more potential network addresses of the retrieved first data file as network addresses; and determining if a network address is the network address of the peripheral device.”

Furthermore, the terminal of Lacome receives “the network address of the peripheral associated to the terminal” from the server. Because the terminal of Lacome receives the network address of the peripheral associated with the terminal, it is unnecessary for the terminal of Lacome to perform additional steps to determine the network address of the peripheral such as “comparing the

one or more potential network addresses of the retrieved first data file with a predetermined data formatting pattern indicative of a network address” and “determining if a network address is the network address of the peripheral device.”

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Lacome. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Lacome does not disclose all of the subject matter of claim 1.

Claims 2 and 3 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 3 be withdrawn.

Claims 9 and 17 as amended include subject matter similar to the subject matter of claim 1. As such, Applicant respectfully requests that the rejection of claims 9 and 17 be withdrawn because Lacome does not disclose all of the subject matter of claims 9 or 17.

Claims 10 and 11 depend either directly or indirectly from claim 9. Claims 18 and 19 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 10, 11, 18 and 19 be withdrawn.

II. Claims 4-8, 12-16 and 18-24 Rejected Under 35 U.S.C. § 103(a)

Claims 4-8, 12-16 and 18-24 stand rejected under 35 U.S.C. § 103(a) based on Lacome in view of U.S. Patent Application Publication No. 2002/0059489 to Davis et al. (hereinafter, “Davis”). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int’l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, “obviousness requires a suggestion of all limitations in a claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an

obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at **37. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

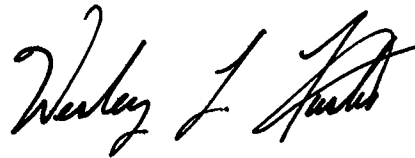
Claims 4-8 depend either directly or indirectly from claim 1. Claims 12-16 depend either directly or indirectly from claim 9. Claims 18-24 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 4-8, 12-16 and 18-24 be withdrawn for the reasons above.

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Amdt. dated December 22, 2008
Reply to Office Action of September 22, 2008

III. Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being the most prominent.

/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

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AUSTIN RAPP & HARDMAN
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: (801) 537-1700